

## REMARKS

The Office Action mailed February 13, 2004 has been reviewed and carefully considered. Claims 1-14 remain pending, of which the independent claims are 1, 3, 5, 8 and 11. Claim 3 has been amended. Reconsideration of the above-identified application, as amended and in view of the following remarks, is respectfully requested.

Claims 1-14 stand rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,208,854 to Roberts et al. ("Roberts").

Claim 1 recites:

... instructing, at said calling end, whether to establishing a call connection when an originating call is routed to a new number through said call forwarding service;  
determining whether a message indicating that said originating call from said calling end is routed to said new number; and  
selectively establishing said call connection to said new number if said calling end is instructed to establish said call connection through said call forwarding service.

Roberts discloses instructing, e.g., as by an interactive voice response (IVR) unit (col. 5, line 24), at the receiving end, but not at the "calling end." Instructing "at said calling end" is explicitly required by the language of claim 1. For at least this reason, Roberts fails to anticipate the invention as recited in claim 1.

Claim 3 as amended recites:

... upon receiving said incoming call at said receiving end, determining whether said incoming call is a forwarded call via said call forwarding service, the forwarding of said forwarded call occurring in said network from one intended recipient party of said incoming call, to the telephone of another party . . .

Roberts relates to forwarding a call to a party's land-line unit to the party's

mobile unit, if the mobile unit is determined to be available for the call (abstract, second sentence). Claim 3 now specifies, by contrast, “the forwarding of said forwarded call occurring in said network from one intended recipient party of said incoming call, to a telephone of another party.” Claim 3 is not anticipated by Roberts at least for this reason. Support for the amendment of claim 3 is found in the specification (e.g., page 2, lines 3-6).

Claim 5 recites:

A method for establishing a call connection between a calling terminal and a receiving terminal in a telecommunication network having a call forwarding service, comprising the steps of:  
pre-programming each terminal of said network to accept or refuse said call connection performed through said call forwarding service

The telecommunication network in Roberts entails at least one calling terminal (FIG. 4, arrow to SSP 430), and claim 5 requires the pre-programming of “each terminal.”

Although Roberts discloses engaging or disengaging the wireless/land-line call routing service by means of the IVR unit (col. 5, line 24) as discussed above, this amounts to pre-programming of a called (col. 5, line 25: “called”) terminal.

By contrast, there is no disclosure or suggestion that the Roberts calling terminal experiences “pre-programming . . . to accept or refuse said call connection.”

Presuming that the Roberts calling terminal receives a call, and that an IVR procedure is executed during that call, amounts to pure speculation. Even imagining that the Roberts calling terminal has a counterpart terminal belonging to the same subscriber amounts to mere speculation. It is even further speculation to presume that each terminal

of the "telecommunication network" is pre-programmed "to accept or refuse said call connection."

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) MPEP 2131.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In *re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In *re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In *re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) MPEP 2112.

Roberts fails to disclose or suggest "pre-programming each terminal of said network to accept or refuse said call connection" and fails to anticipate the invention as recited in claim 5 for at least this reason.

Claim 8 likewise recites the same limitation and is deemed to be patentable over Roberts for at least the same reason set forth above with regard to claim 5.

Claim 11 recites:

determining whether said calling subscriber and said terminating subscriber are pre-programmed to establish said call connection when said originating call is routed to said terminating subscriber through said call forwarding service

Roberts fails to disclose or suggest "determining whether . . . when said

originating call is routed to said terminating subscriber.” For at least this reason, Roberts fails to anticipate the invention as recited in claim 11.

Claims 1-4 stand rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,583,564 to Rao.

Rao fails to disclose or suggest “selectively establishing said call connection to said new number if said calling end is instructed to establish said call connection . . .”

Rao is directed to an intelligent call forwarding system, but to suggest that Rao discloses the above limitation amounts, again, to pure speculation. For at least this reason, Rao fails to anticipate the invention as recited in claim 1.

Regarding claim 3, Rao fails to disclose or suggest “upon receiving said incoming call at said receiving end, determining whether said incoming call is a forwarded call . . .” For at least this reason, Rao fails to anticipate the invention as recited in claim 3.


For the remaining rejected claims, each depends from a base claim and is deemed to be patentable for at least the same reason(s).

In view of the foregoing amendments and remarks, it is believed that this application is now in condition for allowance. The Examiner is invited to contact the undersigned in the event of any perceived outstanding issues so that passage of the case to issue can be effected without the need for a further Office Action.

In the event that any additional fee is required to continue the prosecution of this Application as requested, please charge such fee to Deposit Account No. 502-470.

Respectfully submitted,

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5/13/04

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